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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/406,001 09/24/99 HIATT, JR.

A HTT-9901

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LM02/0523

EXAMINER

CRAVER, C

ART UNIT

PAPER NUMBER

2744

DATE MAILED:

05/23/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/406,001**

Applicant(s)  
**Hiatt, Jr.**

Examiner  
**Charles Craver**

Group Art Unit  
**2744**



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 4, 5, 14 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claims 4 and 5 recite the limitation "the internet protocol" in line 1 of both claims. There is insufficient antecedent basis for this limitation in the claims.
4. Claims 14 and 20 recite the limitation "the file of addresses" in line 3 of both claims. There is insufficient antecedent basis for this limitation in the claims.

### ***Claim Objections***

5. Claim 10 is objected to because of the following informalities:
6. Claim 10, step (d) recites the limitation "transferring an addresses" in line 11 of page 13. This limitation makes it unclear as to whether a single address or multiple addresses are to be transferred. Appropriate correction is required.

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***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1, 2 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Patsiokas.

**Regarding claim 1,**

Patsiokas discloses a system for transferring an address list comprising:

a portable wireless device (12)

a wireless communication system (see FIG 1) capable of establishing a wireless communication link with the device (col 1 line 64-col 2 line 11)

a wireline network (16) connected to the wireless network (see FIG 1)

a computer (82, 90) connected to the wireline network, the computer capable of sending a plurality of addresses to the wireless device (col 3 line 23-col 4 line 3, col 2 lines 12-23), the computer inherently using address software.

**Regarding claim 2,**

Patsiokas discloses that said wireless device is a cellular telephone (col 1 line 64-col 2 line 11).

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**Regarding claims 6-8,**

Since Patsiokas discloses that the wireless device may request a telephone number for a transfer (col 2 lines 18-23) as set forth in claim 7, it is assumed that the wireless device further contains software to accomplish such a goal, i.e. an address transfer program, as set forth in claim 6. Further regarding claim 8, since Patsiokas further discloses that a file may be specified (a daily schedule, for example, col 2 lines 21-22), in such a case said wireless device would inherently request said file by name.

**Regarding claim 9,**

Patsiokas further discloses that said wireless device may allow a user to select for transfer telephone number (i.e. phone book) data, which reads a plurality of address fields (col 2 lines 18-23).

9. Claims 10-14, 16 and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Mills.

**Regarding claims 10 and 11,**

Mills discloses a method for transferring address information comprising  
at a first electronic device (100 comprising computer 10), setting up a communication path between it and a second device, including a wireless and wireline portion (col 5 lines 14-40 see FIG 3), inherently comprising a step of selecting or using transfer software to do so and using or entering an address of said second device, and

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transferring SIM information, including in part, a list of addresses from the second device to the first device (col 5 lines 41-57).

**Regarding claim 12,**

Mills further discloses that said data may be transferred from the first device to the second (col 3 lines 16-63).

**Regarding claims 13 and 14,**

Mills further discloses that said requested address data may comprise a file of address data (i.e. dial lists, col 1 lines 39-41), or an individual address (i.e. field) in the device memory, i.e. a credit card number (col 4 line 56-col 5 line 13).

**Regarding claim 16,**

Since the second device of the invention of Mills is a cellular telephone (col 1 lines 12-30), and uses SMS or USSD, it is inherent that it would be identified by its telephone number when a data request message is to be sent to it via said messaging protocols.

**Regarding claim 18,**

Mills discloses a computer (10) for performing a process, inherently via a program, comprising

requesting an address of an electronic device when an address is to be transferred, establishing a communications link via a communications network with said device, and receiving a plurality of addresses (col 5 lines 14-57).

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Further, since it is disclosed that said request is in response to the actions of an operator, for example an airline agent, it would be inherent that such a request would be made via said software at said computer terminal (10) using, for example, an "address transfer" option.

**Regarding claims 19 and 20,**

Mills further discloses that said requested address data may comprise a file of address data (i.e. dial lists, col 1 lines 39-41), or an individual address (i.e. field) in the device memory, i.e. a credit card number (col 4 line 56-col 5 line 13).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mills.

As shown above, Mills discloses applicants invention of claim 1. However, Mills does not specifically disclose that said network operates under a digital PCS wide area network protocol. However, such a feature was well known in the art at the time of the invention, and as such the examiner takes Official Notice of such a feature. It would have been obvious, noting Mills' disclosure that a SIM card may be used in a PCS system (col 1 lines 12-30), that such a memory

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transfer method may be applied to a PCS wide area network, as it would allow the invention of Mills to operate on new communication systems and standards.

12. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills as applied to claim 1 above, and further in view of Günlük.

While disclosing all of the limitations set forth in claim 1 as shown above, Mills does not specifically recite that said network may operate according to a hypertext (i.e. internet) protocol or an electronic mail protocol.

Günlük discloses that it is useful in a wireless messaging system using, for example, SMS, to allow interoperability, that is, to operate the network such that SMS and other such messaging protocols may be translated into other protocols for messaging interoperability, said other protocols including electronic mail and TCP/IP (i.e. hypertext) (see FIG 2, col 3 lines 55-67). Therefore, it would have been obvious to one skilled in the art to add such a feature to Mills as it would offer a higher performance message routing method.

13. Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills as applied to claim 10 above, and further in view of Günlük.

While disclosing all of the limitations set forth in claim 1 as shown above, Mills does not specifically recite that said network may operate according to a hypertext (i.e. internet) protocol or an electronic mail protocol such that a URL or E-mail address is entered rather than a phone number to contact the wireless device.



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Günlük discloses that it is useful in a wireless messaging system using, for example, SMS, to allow interoperability, that is, to operate the network such that SMS and other such messaging protocols may be translated into other protocols for messaging interoperability, said other protocols including electronic mail and TCP/IP (i.e. hypertext) (see FIG 2, col 3 lines 55-67). Therefore, it would have been obvious to one skilled in the art to add such a feature to Mills as it would offer a higher performance message routing method, and thus allow better access to the information present in the wireless device.

### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tamura discusses a method for communicating address data between wireless telephones.

Piosenka et al and Metso et al discuss methods for transferring address data between a wireless device and a computer.

Kennedy, III et al discusses a method for storing mobile data at a computer in a network.

Comer et al discusses a method for receiving and storing data from a wireless device at a computer in a network.

Foti discusses a method for storing user profile information at a network and transferring said data to the user.

Carlsson et al discusses a method for storing user data at a network computer.

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Honda discusses a method for transferring data from a first terminal to a base station, and subsequently to a second terminal.

**15. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**Or:**

(703) 305-9508 (for informal or draft communications, please label "PROPOSED" or "DRAFT")


Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, sixth floor (receptionist).

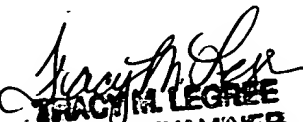
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Craver whose telephone number is (703) 305-3965.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost, can be reached on (703) 305-4778.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

C. Craver  
May 19, 2000

  
**CHARLES CRAVER**  
**PATENT EXAMINER**

  
**TRACY M. LEGREE**  
**PATENT EXAMINER**